

**REMARKS**

Claims 1-8 are pending in the instant application. Claim 5 is amended herein. No new matter is added by the amendments, which are supported throughout the specification and figures. In view of the amendments and the following remarks, Applicants respectfully request that the pending claims be allowed.

Claims 5-7 are rejected under 35 U.S.C. 112, first paragraph, as failing the written description requirement. Applicants respectfully traverse.

Applicants have amended the language of claim 5 so that it recites that the mobile terminal receives the first or second groups of information, and that such information is sent by the network responsive to a saturated cell condition. It is respectfully submitted that the amended claim is supported at least by the communication represented by element 4 in figure 1.

Additionally, Applicants have deleted the limitation relating to the network sending to the mobile terminal the second group of system information after sending the information that the current cell is saturated. Therefore, it is respectfully submitted that the amended claims satisfy the written description requirement, and therefore it is respectfully requested that the rejection be withdrawn.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent Publication No. 2003/0189912 to Laitinen et al. (hereinafter referred to as Laitinen) in view of United States Patent No. 5,701,585 to Kallin et al. (hereinafter referred to as Kallin) and United States Patent No. 5,749,055 to Dahlin (hereinafter referred to as Dahlin). Applicants respectfully traverse.

Initially, it appears that claim 8 is also rejected on the same basis as claims 1-7, but clarification of the basis of the apparent rejection of claim 8 is respectfully requested in the next Office communication.

Claim 1 relates to a method of handover in a multimode mobile telecommunication network. The method of amended claim 1 includes, *inter alia*, ***determining that a mobile terminal is in a saturated cell***, and ***after the determining operation***, and ***in order to initiate a handover, sending by the network to a mobile terminal a first group of system information via a first channel associated with circuit switching services and a second group of system information via a second channel associated with packet switching service***.

The Office Action relies on Laitinen as apparent disclosure of the feature of sending by the network to a mobile terminal a first and second groups of information (Office Action; page 4, citing Laitinen; para. 0025) in a disclosure apparently relating to a dual-mode mobile station receiving SI2 and a PSI3 messages. However, the cited section of Laitinen relates to measurements in packet broadcasting cells which are made ***prior*** to the initiation of a handover. In stark contrast, in the amended claim, the performing of measurements are made ***to initiate a handover***, and these measurements are made ***after determining that a mobile terminal is in a saturated cell***. The Office Action states, in regard to another feature of the claim, that “when the mobile station transitions from a GPRS dedicated mode to a GSM dedicated mode, the MS immediately make measurements ... on packet system information ...” (Office Action; page 5, top). However, as argued previously, absent from this characterization is that the measurements made in the GPRS mode are apparently made ***after a determination that the mobile station is in a saturated cell***, and that the measurements are made in order to initiate a handover. It is respectfully submitted that neither of Laitinen nor Kallin disclose or suggest this feature.

Furthermore, the new reference Dahlin also does not disclose or suggest the feature of sending by the network to a mobile terminal a first group of system information via a first channel associated with circuit switching services and a second group of system information via a second channel associated with packet switching service, *in order to initiate a handover*. Though Dahlin apparently relates to handover in saturated cells, and to transitions to analog systems (Dahlin; col. 11, lines 33-56), there is no indication in Dahlin relating to, *after a determining operation and in order to initiate a handover*, sending by the network to a mobile terminal a first group of system information via a first channel associated with circuit switching services and a second group of system information via a second channel associated with packet switching services.

This feature is significant for the reasons discussed in the specification, and relating to an efficient and speedy handover of a mobile unit when a cell is saturated. As admitted in the Office Action, Laitenen does not relate to handovers and does not discuss saturated cells. The combination of these references does not disclose or suggest this significant feature, and therefore the rejection of the claims should be withdrawn.

Furthermore, the combination of the references is improper. The Office Action does not provide any suggestion as to the *manner* of making the combination of the references. The Office Action does not provide any additional support for the motivation to combine the references. As discussed above, the present invention provides the unexpected benefit discussed in the specification of providing an efficient and speedy handover in a dual mode mobile communication system in response to a saturated cell condition. It is respectfully submitted that there is no motivation to combine Dahlin, Kallin, or Laitenen, and therefore the rejection is improper and amended claim 1 is allowable over the references.

Claims 2-4 and 6 depend from claim 1 and are therefore allowable for at least the same reasons as claim 1 is allowable.

Claim 5 recites features similar to claim 1 and is therefore allowable for at least the same reasons as claim 1 is allowable. In particular, amended claim 5 recites that the mobile terminal includes means for receiving by the mobile terminal from the network one of a first group of system information sent by the network to the mobile terminal via a circuit switching channel and a second group of system information sent by the network to the mobile terminal via a packet switching channel *after a determination by the network that a current cell is saturated requiring a handover in the network*. Therefore, for at least the same reasons as claim 1 is allowable, amended claim 5 is allowable.

Claim 7 depends from claim 5 and is therefore allowable for at least the same reasons as claim 5 is allowable.

Claim 8 relates to a handover method for a mobile terminal in a mobile communication network. The method of claim 8 includes, *inter alia*, *in response to a determination that the mobile terminal is in a saturated cell, sending by the network to the mobile terminal packet system information via a packet switching channel, the packet system information including GPRS frequencies for neighboring cells, and performing measurements by the mobile terminal, based on the packet system information, in a first neighboring cell*. Claim 8 also includes *initiating a handover according to the result of the measurements*, and *after the step of performing measurements by the mobile terminal, the network sends to the mobile terminal circuit system information via a circuit switching channel, the circuit system information including GSM frequencies for neighboring cells*.

The Office Action selectively chooses among the various references to an extent that robs the limitations of all their meaning. The instant invention relates to handover of a mobile unit from a saturated cell, and utilizes dual modes of communication. As admitted in the Office Action, Laitenen does not relate to handover from a saturated cell, and Applicants submit that Dahlin does not disclose the transmission of the two groups of information. The combination of the references does not disclose or suggest the significant feature of the present invention of, in response to a determination that the mobile terminal is in a saturated cell, sending by the network to the mobile terminal packet system information via a packet switching channel, the packet system information including GPRS frequencies for neighboring cells, and performing measurements by the mobile terminal, based on the packet system information, in a first neighboring cell. Therefore, claim 8 recites features similar to claim 1 and is therefore allowable for at least the same reasons as claim 1 is allowable.

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**CONCLUSION**

In view of the remarks set forth above, this application is believed to be in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action. Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,

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